



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

JAN 09 2002

OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 AVENUE OF THE AMERICAS
NEW YORK, NEW YORK 10036-8403

In re Application of :
TAYLOR et al. :
Application No.: 09/744,613 :
PCT No.: PCT/US99/16968 : DECISION ON
Int. Filing Date: 28 July 1999 :
Priority Date: 28 July 1998 : 37 CFR 1.42 PAPERS
Attorney Docket no.: P/3501-9 :
For: ENHANCEMENT OF PROFILED TUBULAR :
LINING SYSTEMS BY CHANNEL AUGMENTATION :

This is a decision on the submission under 37 CFR 1.42 filed in the United States Patent and Trademark Office (USPTO) on 20 September 2001 along with a newly executed declaration for the above referenced application.

BACKGROUND

On 26 January 2001, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee and a Preliminary Amendment.

On 13 February 2001, a Notification of Missing Requirements was mailed to applicants indicating that an executed oath or declaration was required along with a \$130 surcharge for filing the oath or declaration after the thirty month period.

On 19 March 2001, in order to satisfy the requirement that an oath or declaration of the inventors be furnished, applicants also filed a declaration that was signed by applicant/inventor Jack Curtis Taylor, Louise F. Roach as "executrix" for inventor Max Jerry Roach (deceased). Applicants also filed the Last Will and Testament of Max Jerry Roach.

On 20 July 2001, a decision was mailed to applicants indicating that the declaration was unacceptable although signed by the legal representative of the deceased inventor, because it failed to provide her country of citizenship, residency and mailing address respectively. See 37 CFR 1.64.

On 20 September 2001, a new declaration was filed by applicants identifying the inventors and their country of citizenship and stating the citizenship, residency and mailing address of the heir(s)/legal representative.

DISCUSSION

37 CFR 1.497(a)(3) requires that the declaration must identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. Furthermore, 37 CFR 1.497(b)(2) states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must also state that the person is a legal representative and the citizenship, residency and mailing address of the heir(s)/legal representative.

The declaration submitted on 29 March 2001 was executed by first joint inventor Jack Curtis Taylor and by Louise F. Roach as the "executrix of the estate of" applicant/inventor Max Jerry Roach. Beneath Ms. Roach's signature, appeared the residence, country of citizenship and mailing address of deceased inventor Max Jerry Roach. Pursuant to 37 CFR 1.497(b)(2), the declaration was unacceptable because the executrix's residence, citizenship and mailing address were not provided.

The declaration submitted on 20 September 2001 identifies Louise F. Roach as the "executrix of the estate of" applicant/inventor Max Jerry Roach and states her country of citizenship, former residency and mailing address as required for compliance with 37 CFR 1.497(a)(3) as well as identifying the first inventor and the deceased inventor and their country of citizenship, residency and mailing address respectively. However, the new declaration is not signed by the legal representative Louise F. Roach but is signed by "Stephen R. Roach for Louise F. Roach". This is unacceptable as it does not meet the requirements of 37 CFR 1.497(a)(3). See also 37 CFR 1.64 and MPEP 605.04(a).

Furthermore, it is noted that the declaration is accompanied by a power of attorney executed by Louise Roach and naming Stephen R. Roach as attorney-in-fact. While the power of attorney enumerates the powers transferred to Stephen Roach, the power to act in matters involving intellectual property is not included.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is presently **DISMISSED WITHOUT PREJUDICE**.

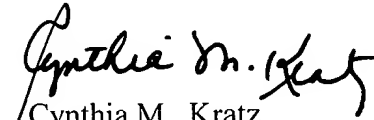
Any reconsideration on the merits of the petition under 37 CFR §1.42 must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.42." No additional

petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Richard R. Cole
Legal Examiner
PCT Legal Office



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/RRC:cmk

Telephone: (703) 306-5467

Facsimile: (703) 308-6459